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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,571	08/16/2001	Tim Daniels	Z-0006	4993

7590 09/26/2006

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EXAMINER

WASSUM, LUKE S

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 09/26/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/932,571

Filing Date: August 16, 2001

Appellant(s): DANIELS ET AL.

Timothy J. Hadlock
For Appellant

EXAMINER'S ANSWER

This is in response to the amended appeal brief filed 31 August 2006 appealing from the Office action mailed 8 June 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 1-3, 5-8, 10, 11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by **Navani et al.** (U.S. Patent Application Publication 2002/0049667).

Claims 4, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Navani et al.** (U.S. Patent Application Publication 2002/0049667) in view of **Hager et al.** (U.S. Patent 6,085,808).

Claims 1, 2, 6, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbieri et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business Wire** ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution").

Claims 4, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbieri et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business Wire** ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution") in view of **Hager et al.** (U.S. Patent 6,085,808).

Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbieri et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business Wire** ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution") in view of **Peterson et al.** (U.S. Patent Application Publication 2001/0011232).

Claims 5, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbieri et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business Wire** ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution") in view of **Phillips et al.** (U.S. Patent Application Publication 2002/0116348).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0049667	NAVANI et al.	04-2002
6,085,808	HAGER et al.	07-2000
2002/0013721	DABBIERE et al.	01-2002

2001/0011232	PETERSON et al.	08-2001
2002/0116348	PHILLIPS et al.	08-2002

Business Wire "Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution", 2 August 1999.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 5-8, 10, 11 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by **Navani et al.** (U.S. Patent Application Publication 2002/0049667).

Claims 4, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Navani et al.** (U.S. Patent Application Publication 2002/0049667) in view of **Hager et al.** (U.S. Patent 6,085,808).

Claims 1, 2, 6, 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbieri et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business Wire** ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution").

Claims 4, 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbieri et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business**

Wire ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution") in view of **Hager et al.** (U.S. Patent 6,085,808).

Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbieri et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business Wire** ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution") in view of **Peterson et al.** (U.S. Patent Application Publication 2001/0011232).

Claims 5, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dabbieri et al.** (U.S. Patent Application Publication 2002/0013721) in view of **Business Wire** ("Petrolsoft Introduces Wholesale Supply-Chain Planning Solution for Refinery-to-Terminal Distribution") in view of **Phillips et al.** (U.S. Patent Application Publication 2002/0116348).

These rejections are set forth in a prior Office action, mailed on 8 June 2005.

(10) Response to Argument

This Examiner's answer will address the arguments in the order in which they appear in the appeal brief.

A. Issue 1

The 131 Affidavit is Not Effective to overcome the Applied References

Regarding the 131 affidavit, the Appellants argue broadly that the 131 affidavit is sufficient to remove the **Navani et al.** and **Dabbiere et al.** references as prior art, and more particularly that (1) the examiner improperly rejected the 131 affidavit because the dates of the exhibits were redacted, that (2) the affidavit's express recital of due diligence is sufficient to establish said diligence, and that (3) the exhibits accompanying the 131 affidavit are sufficient to show possession of the claimed invention.

In response, the examiner presents the following arguments.

Regarding **argument (1)** [that the examiner improperly rejected the 131 affidavit because the dates of the exhibits were redacted], the examiner respectfully disagrees.

The examiner never asserted that the Appellants' 131 affidavit was defective because the dates of the accompanying exhibits were redacted. The only mention of the redacted dates in the rejection of record, mailed 8 June 2005, was in paragraph 17, discussing diligence.

Therein, the examiner listed the exhibits submitted as evidence with the 131 affidavit, noting that they were undated, and stated that "The Applicants have failed to meet their burden of providing explicit facts and supporting evidence which would demonstrate diligence in reducing the invention to practice over the critical period, which in this case begins 22 May 2000 and ends on the date the instant patent application was filed." The redaction of dates, while noted by the examiner, was not the basis for concluding that the 131 affidavit was ineffective.

Regarding **argument (2)** [that the affidavit's express recital of due diligence is sufficient to establish said diligence], the examiner respectfully disagrees.

As stated in paragraphs 15 and 17 of the rejection of record, the Applicants have failed to meet their burden to supply FACTS and supporting documentary evidence and exhibits to show conception and diligent reduction to practice of the claimed invention, as required by 37 C.F.R. §1.131(b) (see MPEP § 715.07 (III)). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. *In re Borkowski*, 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

The Appellants have filed an affidavit which includes only conclusions ("...the invention of the referenced claims was reduced to practice on a date prior to May 22, 2000, or conceived on a date prior to May 22, 2000 and diligently reduced to practice thereafter....the elements of claims 1-13 were in our possession prior to May 22, 2000", see affidavit filed 25 May 2005) instead of the required statement of facts. As such, the affidavit is ineffective to establish conception, diligence and/or reduction to practice of the claimed invention.

The examiner furthermore points out that in the affidavit, the Appellants state that the documents supplied as exhibits to support the affidavit "have a date prior to May 22, 2000 *and/or existed in draft form prior to May 22, 2000*" (emphasis added). Since the exhibits are meant to be relied upon to support conception, diligence and/or reduction to practice prior to 22 May 2000, the fact that the documents *existed in draft form* prior to 22 May 2000 (but presumably were actually dated subsequent to 22 May 2000) means that these document cannot be relied upon, since there is no way to know what changes occurred between the draft versions and the versions submitted as exhibits.

Specifically regarding a showing of diligence, it is not enough merely to allege that the applicant has been diligent; the applicant must show evidence of facts establishing diligence. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889).

In accordance with MPEP § 2138.06, an applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966). The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975). Diligence requires that applicants must be specific as to dates and facts. *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949).

The examiner also points out that the business plan cited as evidence of diligence is just that, a plan. This document has nothing to lend in providing evidence of diligence, since it cannot document specific events and the dates on which those events occurred, but only when they were originally planned to occur.

Finally, the issue as to whether 15 months is a reasonable amount of time in which to reduce an invention to practice in a large corporation is irrelevant to the issue at hand. In order to establish diligence, the affidavit must relate specific acts taken by the applicants in reducing the invention to practice throughout the entire critical period and the dates on which the specific acts took place, accompanied by supporting documentary evidence.

The Appellants have clearly failed their burden to establish diligence, instead merely alleging in their affidavit that they were diligent, while failing to supply the required facts and evidence to support said facts.

Regarding **argument (3)** [that the exhibits accompanying the 131 affidavit are sufficient to show possession of the claimed invention], the examiner respectfully disagrees.

The examiner's remarks made in response to argument (2) above, regarding the Applicants' failure to provide facts, as well as clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant, apply as well to the issue of conception.

As well as the requirement for facts, the Applicants are required to clearly explain where or how each claimed feature is shown in the exhibits, unless otherwise accounted for in the affidavit, or unless the missing features would have been obvious to a skilled artisan at the time of the invention.

Lacking any statement of facts, as well as any clear explanation of what fact(s) each exhibit is relied upon to support (and including where in the exhibits the claimed features can be found unless those features would have been obvious to an ordinary artisan), the Applicants' affidavit fails to establish conception of the claimed invention prior to the date of the applied references, and as such is ineffective to remove the references as prior art.

For these reasons, the examiner maintains that the rejection of claims 1-13 is proper and should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

Claims 1-13 are properly rejected under 35 U.S.C. § 102(e) and/or 103(a).

In light of the foregoing arguments, the Examiner respectfully requests the Honorable Board of Appeals to sustain the rejections.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




Luke S. Wassum
Primary Examiner
Art Unit 2167

Conferees:

John R. Cottingham

Hosain T. Alam



lsw
19 September 2006